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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,531	05/31/2002	Katsuji Shibata	P22180	9253

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RESTON, VA 20191

EXAMINER
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HERTZOG, ARDITH E

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,531

Applicant(s)

SHIBATA ET AL.

Examiner

Ardith E. Hertzog

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/2, 5/31, 2002 & 1/20, 7/12, 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 2,3,12,13,19,24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/2/02 & 7/12/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority/Response to Amendment***

1. This application has been filed under 35 U.S.C. § 371 based upon International Application PCT/JP00/06951, filed October 5, 2000, and published (in English) as WO 01/25317 on April 12, 2001. In accordance with MPEP § 1893.03(e), acknowledgement is made of the corresponding International Search Report (Form PCT/IPEA/210) and International Preliminary Examination Report (Form PCT/IPEA/409). Acknowledgment is also made of applicant's claim for priority under 35 U.S.C. § 119(a)-(d); the certified copies have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). Claims 1-25 are pending.

### ***Information Disclosure Statements***

2. Receipt is hereby acknowledged of the information disclosure statement (IDS) filed April 2, 2002 and the IDS filed July 12, 2004. As each submission is in compliance with the provisions of 37 CFR § 1.97, each IDS has been considered, in accordance with the enclosed PTO-1449 forms.

### ***Oath/Declaration***

3. The declaration is defective because:

It does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month and year of its filing.

Note that in the executed declaration, filed May 31, 2002, the day and month for the filing date of each priority document has been transposed; that is, each priority

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document is incorrectly identified as having been filed "10/Jul/99" (rather than "7/Oct/99"). **Accordingly**, a new declaration (or oath) in compliance with 37 CFR § 1.67(a), **or** application data sheet (see 37 CFR § 1.76 and MPEP § 601.05), identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

### ***Abstract***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure:

The abstract should be in narrative form and **generally limited to a single paragraph** on a separate sheet within the range of 50 to 150 words. ...

The language should be clear and concise and should not repeat information given in the title. **It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.** (MPEP § 608.01(b))

5. The abstract of the disclosure is objected to, per the bolded citations above, because: it is two paragraphs long; it begins with "The present invention is directed to"; and the last sentence of the first paragraph begins with "It is also directed to". Appropriate correction is required.

### ***Minor Informalities***

6. The disclosure is objected to, because of the following minor informalities:
- a. "While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with 'I (or we) claim,' 'The invention claimed is' (or the equivalent)" (see MPEP § 608.01(m)).
  - b. In **each of** claims 2, 12 **and** 24, the last line, "organic salts" should evidently be revised as "organic acids", per page 11, line 8, of the specification

(note related 35 U.S.C. § 112, second paragraph, rejection in paragraph 10. below).

Appropriate correction of all the above is required.

### ***Claim Objections***

7. Claims 2, 3, 12, 13, 19, 24 and 25 are objected to, because each contains improper Markush group and/or alternative language; see MPEP § 2173.05(h) I.

Specifically:

- a. In claim 2, at line 3, "the group consisting of" should be inserted after "selected from" **and**, at lines 4 and 5, **all three** occurrences of "and/or" should be replaced with "and".
- b. In claim 3, at line 2, "the group consisting of" should be inserted after "selected from".
- c. In claim 12, at line 3, "the group consisting of" should be inserted after "selected from" **and**, at lines 4 and 5, **all three** occurrences of "and/or" should be replaced with "and".
- d. In claim 13, at line 2, "the group consisting of" should be inserted after "selected from".
- e. In claim 19, at line 4, "and" should be replaced with "or".
- f. In claim 24, at line 3, "the group consisting of" should be inserted after "selected from" **and**, at lines 4 and 5, **all three** occurrences of "and/or" should be replaced with "and".
- g. In claim 25, at line 2, "the group consisting of" should be inserted after

“selected from”.

Appropriate correction of all the above is required.

***Claim Rejections - 35 U.S.C. § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are considered vague, indefinite, and/or confusing, due to the word “treating”, as recited in independent claim 1 (upon which claims 2-10 ultimately depend) and step (1) of independent claim 11 (upon which claims 12-22 ultimately depend). In particular, **how** is the “epoxy resin-cured product” of claim 1 subjected to “treating... with a treatment liquid... to decompose and dissolve the epoxy resin-cured product”, as recited therein? Analogously, **how** is the “composite material of inorganic matter and epoxy resin-cured product” of step (1) of claim 11 subjected to “treating... with a treatment liquid... to decompose and dissolve the epoxy resin-cured product”, as recited therein? It is respectfully submitted that the verb “treating” fails to define **at least one positive method step** in claim 1 and step (1) of claim 11, and thus the intended scope of method claims 1-22 cannot be accurately determined. One means of overcoming this rejection would be to insert “, wherein said product is contacted with said liquid” at the end of claim 1; **and** to insert “, wherein said material is contacted with said liquid” before “; and” at the end of step (1) of claim 11 (or some similar language of applicant’s choosing, wherein **at least one positive method**

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**step** describing **how** the “product” of claim 1/“material” of claim 11, step (1), is subjected to “treating” with the “treatment liquid”). Appropriate correction is required.

10. Claims 6 and 11-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims are considered vague, indefinite, and/or confusing, due to antecedent basis problems. With respect to claims 6 and 16, neither claim 2 (upon which claim 6 depends) nor claim 12 (upon which claim 16 depends) provides proper antecedent basis for “the salts of organic **acids**” (emphasis added), as recited therein. As discussed in paragraph 6.b. above, “organic salts” should evidently be revised as “organic acids”, per page 11, line 8, of the specification, in the last line of both claims 2 and 12 (as well as claim 24). With respect to claims 11-22, there is insufficient antecedent basis in step (1) of independent claim 11 (upon which claims 12-22 ultimately depend) for “the liquid obtained in the step (1)”, as recited in step (2) of claim 11. Note that, although step (1) recites “treating... with a treatment liquid”, there is **no** recitation of any “liquid [(subsequently?)] **obtained**” (emphasis added) anywhere in step (1). Appropriate correction of all aspects of this rejection is required.

### ***Claim Rejections - 35 U.S.C. §§ 102 & 103***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-6, 8-10 and 23-25 are rejected under 35 U.S.C. § 102(b) as anticipated by Bolger et al. (US 3,551,204). Bolger et al. teach processes and compositions for recovering electronic devices from encapsulation in “potting compounds”, such as “various epoxy resin systems” (see Bolger et al. title and abstract). Bolger et al. **explicitly** teach that “not only should suitable solvation of the potting compounds be achieved but, as importantly, metallic and other polymeric parts which are embedded in the potting compounds should be recoverable without significant damage thereto” (see col. 1, lines 43-47). In Example 4, a composition containing potassium hydroxide (i.e., “a decomposition catalyst”, as **specifically** recited in instant claims 2, 24, as well as instant claim 4—namely, an “alkali metal salt”) and ethylene glycol monomethyl ether (i.e., “an organic solvent”, as **specifically** recited in instant claims 3 and 25—namely, an “ether-based solvent”) is shown to “dissolve... completely” “an epoxy-resin based encapsulation formation” (i.e., “an epoxy resin-cured product”, per instant independent claims 1 and 23—note that this exemplary “epoxy-resin based... formulation” is evidently cured via the polyazelaic polyanhydride and/or benzyl dimethylamine) (see cols. 3-4, noting formulation of Example 1 in col. 3). Note that Example 4 takes place “under atmospheric pressure”, per instant claim 9, and that the hydroxide-ether solvent composition “has a temperature of 250° C or lower in air”, per instant claim 10.

**Accordingly**, Bolger et al. **anticipate** instant claims 1-6, 9, 10 and 23-25, since compositions and “treating” methods utilizing same, which meet all material limitations of these claims, as broadly recited therein, are **clearly exemplified**. **Moreover**, Bolger et al. **are** also considered to **anticipate** instant claim 8, since, again, the Example 4 composition **clearly** meets all required limitations of applicant’s **composition** claims 23-25, with the Example 4 “treating” method clearly meeting all required limitations of applicant’s **method** claim 1 (upon which instant claim 8 depends). **Therefore**, it is respectfully submitted that **any** “decomposition product of the epoxy resin-cured product [, shown to dissolve completely in (Bolger et al.) Example 4, must **inherently**] contain... a compound recyclable as a raw material of synthetic resins”, as required by instant claim 8 (given that all other required limitations of applicant’s composition claims, as well as applicant’s “treating” method claim 1, are **clearly** met by Example 4). **Lastly**, note that instant claims 5 and 6 have been included in this rejection, given that each simply recites further limitations for applicant’s “salts of phosphorous-containing acids” and “salts of organic acids” “decomposition catalyst” **if present**; that is, neither instant claim 5 nor instant claim 6 **requires** that the “decomposition catalyst” be anything other than one of applicant’s “decomposition catalyst” species, as recited in instant claim 2 (upon which instant claims 5 and 6 depend).

14. Claims 11-16 and 18-22 are rejected under 35 U.S.C. § 102(b) as anticipated by **or, in the alternative**, under 35 U.S.C. § 103(a) as obvious over Bolger et al. Bolger et al. are relied upon as just set forth, **anticipating** instant method claims 1-6 and 8-10. Initially, it is noted that instant method claims 11-16 and 20-22 are **basically identical**

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**in scope to**, respectively, instant method claims 1-6 and 8-10, **except** for the addition of step (2) in applicant's independent claim 11, i.e., "separating the inorganic matter from the liquid obtained in the step (1)" in the instantly claimed "method of separating a composite material of inorganic matter and epoxy resin-cured product". **Thus**, instant claims 11-16 and 20-22 **cannot** be considered similarly anticipated by Bolger et al. Example 4, in that **only** the epoxy cured-resin is contacted with the hydroxide-ether solvent composition; that is, there is no "composite material of inorganic matter..." in this example. **However**, Bolger et al. claim 1 recites:

A process for recovering **electronic devices and wiring** from encapsulation in polyurethane, polyester and epoxy potting compounds **without damaging said devices or wiring** comprising:  
(1) immersing said encapsulated devices or wiring in a solvent composition consisting essentially of (a) about 0.1 to 3.0 parts by weight of water, (b) about 3 to 7 parts by weight of an alkali metal hydroxide and (c) about 96.9 to 90 parts by weight of an organic solvent selected from the group consisting of 5 lower monohydric alkanols of 2 to 4 carbon atoms, ethylene glycol mono alkyl ethers wherein the alkyl group contains up to 4 carbon atoms, and mixtures thereof; and  
(2) maintaining said devices or wiring in said solvent composition until substantially all said potting compound is dissolved **and removing residual solvent composition from said devices or wiring**. (cols. 4-5, emphasis added)

**Accordingly**, Bolger et al. may **also** be considered to **anticipate** instant claims 11-16 and 20-22, since methods "of separating", which meet all material limitations of these claims, as broadly recited therein, are **clearly claimed**. That is, Bolger et al. steps (1) and (2), as cited above, read on applicant's claim 11 steps (1) and (2), with the Bolger et al. "alkali metal hydroxide" reading on applicant's "decomposition catalyst", as **specifically** recited in instant claims 12 and 14 (i.e., an "alkali metal salt"), and the Bolger et al. "lower monohydric alkanols" and "ethylene glycol mono alkyl ethers"

reading on applicant's "organic solvent", as **specifically** recited in instant claim 13 (i.e., "alcohol-based solvents" and "ether-based solvents"). Note that the Bolger et al. claimed process clearly meets the pressure and temperature limitations of, respectively, instant claims 21 and 22. Note that instant claim 20 may be considered **inherently** anticipated by the above claimed process, in accordance with the analogous anticipation rejection of instant claim 8 set forth *supra*. Note that instant claims 15 and 16 have been included in this rejection, given that each simply recites further limitations for applicant's "salts of phosphorous-containing acids" and "salts of organic acids" "decomposition catalyst" **if present**; that is, neither instant claim 15 nor instant claim 16 **requires** that the "decomposition catalyst" be anything other than one of applicant's "decomposition catalyst" species, as recited in instant claim 12 (upon which instant claims 15 and 16 depend). **Further** note that the Bolger et al. claimed process **also** anticipates instant claims 18 and 19, with the recited "electronic devices" considered to encompass the **specific** "composite material[s]" of instant claim 19 and the recited "wiring" **clearly** reading on the "metal" of instant claim 18. **In summary then**, Bolger et al. are considered to **anticipate** instant claims 11-16 and 18-22, since methods "of separating", which meet all material limitations of these claims, as broadly recited therein, are **clearly claimed**. **Alternatively**, it could be argued that Bolger et al. do not **fully** anticipate these claims of applicant, since **no working example** meets each and every material limitation thereof. **However**, even if not anticipated, then, at the least, methods falling within the scope of instant claims 11-16 and 18-22 would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, because,

as just discussed, the broad teachings of Bolger et al.—including the specific subject matter **claimed—clearly encompass** methods meeting all material limitations of these claims of applicant.

15. Claims 7 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolger et al. in view of **any one of** Japanese Unexamined Patent Application Publication No.'s: 8-325436, 8-325437, 8-325438, 9-316445, or 10-126052 (i.e., as cited by applicant on the enclosed PTO-1449 and discussed in the instant specification at p. 4, first full paragraph). Bolger et al. are relied upon as set forth above, anticipating or, at the least, having rendered *prima facie* obvious methods, per applicant's independent claims 1 and 11 (upon which instant claims 7 and 17 respectively depend). Although Bolger et al. teach that the disclosed processes are generally suitable for "selectively dissolving... various epoxy resin systems" (see Bolger et al. abstract), there appears to be no teaching nor suggestion that the "epoxy resin-cured product contains a halogen atom", as **specifically** recited in instant claims 7 and 17.

16. Each of Japanese Unexamined Patent Application Publication No.'s: 8-325436; 8-325437, 8-325438, 9-316445, and 10-126052 establishes that epoxy resin-cured products, wherein the epoxy resin-resin cured product contains a halogen atom, have been known in the art as conventionally used epoxy-resin cured products in the processing of printed wiring boards (see JPO abstracts of each, as submitted by applicant). **Accordingly**, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, when having performed the Bolger et al. processes for "selectively dissolving... various epoxy resin systems" (see again Bolger et al.

abstract), to have selected an epoxy resin-resin cured product **containing a halogen atom** for use therein, because, as just discussed, each of the above-mentioned Japanese Publications establishes that their use in the processing of printed wiring boards was known in the art. When having done so, it is respectfully submitted that, absent evidence otherwise, processes falling within the scope of instant claims 7 and 17 would have obviously resulted.

17. Claims 23-25 are rejected under 35 U.S.C. § 102(b) as anticipated by Harbin (US 5,536,439). See Examples 1 and 4 (cols. 4-5), cleaning compositions containing potassium hydroxide, which reads on applicant's "decomposition catalyst", as **specifically** recited in instant claim 24 (i.e., an "alkali metal compound"), and propylene glycol monomethyl ether and methyl isobutyl ketone, both of which read on applicant's "organic solvent", as **specifically** recited in instant claim 25 (i.e., "ether-based solvent" and "ketone-based solvent"). See Example 11 (col. 5), a cleaning composition containing potassium hydroxide, which reads on applicant's "decomposition catalyst", as **specifically** recited in instant claim 24 (i.e., an "alkali metal compound"), and propylene glycol monomethyl ether and cyclohexanone, both of which read on applicant's "organic solvent", as **specifically** recited in instant claim 25 (i.e., "ether-based solvent" and "ketone-based solvent"). See Example 12 (col. 6), a cleaning composition containing potassium hydroxide, which reads on applicant's "decomposition catalyst", as **specifically** recited in instant claim 24 (i.e., an "alkali metal compound"), and ethylene glycol monobutyl ether and methyl isobutyl ketone, both of which read on applicant's "organic solvent", as **specifically** recited in instant claim 25 (i.e., "alcohol-based

solvent” and “ketone-based solvent”). See Experiment 17 and Example 18 (col. 6), cleaning compositions containing potassium hydroxide, which reads on applicant’s “decomposition catalyst”, as **specifically** recited in instant claim 24 (i.e., an “alkali metal compound”), and propylene glycol monomethyl ether with cyclohexanone and/or methyl isobutyl ketone, the latter three reading on applicant’s “organic solvent”, as **specifically** recited in instant claim 25 (i.e., “ether-based solvent” and “ketone-based solvents”).

**Accordingly**, Harbin **anticipates** instant claims 23-25, since compositions meeting all material limitations thereof, as broadly recited therein, are **clearly exemplified**. It is appreciated that these Harbin examples are cleaning compositions, whereas these claims of applicant recite “treatment liquid [(compositions)] for an epoxy resin-cured product”. **However**, it is respectfully submitted that this different **preamble** language—as a statement of intended use—does not patentably distinguish the instant **composition** claims from those compositions **clearly** disclosed by Harbin, given that, again, these Harbin compositions **clearly** contain components reading on those required by instant claims 23-25 (see MPEP § 2111.02). Also note that any additional components present in these Harbin examples are **not** excluded by these claims of applicant, due to the **open** “containing” language of instant independent claim 23 (see MPEP § 2111.03).

### ***Double Patenting***

18. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

19. A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

20. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

21. Claims 23-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,780,894 B2. Although the conflicting claims are not **identical**, they are **not considered patentably distinct from each other**, for the following reasons: Independent patented **composition** claim 1 **requires**: “a compound having a phosphoric acid structure or salt thereof and an organic solvent, wherein the compound having a phosphoric acid structure is present at an amount between 0.001 to 80% by weight relative to the organic solvent”. Note that these two components **read on** the two components **required** by instant **composition** claims 23-25—namely, applicant’s “decomposition catalyst”, as **specifically** recited in instant claim 24 (i.e., “phosphorous-

containing acids and/or salts thereof”) and applicant’s “organic solvent”. **Further** note that the additional limitations on the “compound having a phosphoric acid structure or salt thereof” in the patented claims (i.e., as recited in patented claims 2-5) are **encompassed** by applicant’s “phosphorous-containing acids and/or salts thereof” component, when instant claim 24 is read in light of the specification (see paragraph bridging instant pp. 12-13). **Further** note that the additional limitations on the “organic solvent” in the patented claims (i.e., as recited in patented claims 6-8) are at least **encompassed** by (if they do not directly read on) applicant’s “organic solvent” component, as **specifically** recited in instant claim 25, when these patented claims are read in light of the specification (see col. 8, line 50 – col. 9, line 36; col. 9, lines 41-46). It is appreciated that these patented claims recite “decomposition treatment liquid[s] for a cured unsaturated polyester resin”, whereas these claims of applicant recite “treatment liquid[s] for an epoxy resin-cured product”. **However**, it is respectfully submitted that this different **preamble** language—as a statement of intended use—does not patentably distinguish the instant **composition** claims from the patented **composition** claims, given that, again, the patented composition claims **clearly** recite components which read on and/or encompassed by those required by instant claims 23-25 (see MPEP § 2111.02). **Thus**, it is respectfully concluded that instant claims 23-25 would have been *prima facie* obvious to one of ordinary skill, in view of patented claims 1-8, for the reasons just discussed.

### **Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. These references are considered **cumulative to or** less material than those discussed above. In particular: Note that the compositions used in Examples I-VII of Hermes (US 3,770,528) consist of sodium/potassium hydroxide and (di-)ethylene glycol. Note that the Bakos et al. (US 4,276,186) compositions may further contain "alkali metal and/or alkaline earth metal base", such as lithium/sodium/potassium hydroxide (see col. 3, lines 3-13; Bakos et al. claim 9). See claims 4 and 5 of Tranberg (US 4,316,322). Note that Compositions A-G in Table I of Ward et al. (US 4,428,871) are based on the combination of a 2-pyrrolidinone (i.e., a 2-pyrrolidone) and a diethylene glycol monoalkyl ether, which may further comprise polyethylene glycol and/or water. **Lastly**, with respect to JP 10-314716 cited by applicant, this document **has** been considered, per the enclosed PTO-1449, **however**, based upon the corresponding JPO abstract submitted by applicant, it is not entirely understood how this publication relates to the subject matter of the instant invention.

23. Any inquiry concerning this communication should be directed to Ardith E. Hertzog at telephone number (571) 272-1347. The examiner can normally be reached on Monday through Friday (from about 7:30 a.m. - 3:30 p.m.).

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached at (571) 272-1358. The fax phone number for the organization where this application is assigned is 703-872-9306.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. For any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AEH

September 13, 2004



**STANLEY S. SILVERMAN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**